

REMARKS

Based upon the foregoing amendments and following remarks, reconsideration and allowance of the present application are respectfully requested.

Currently, claims 12-14, 18, 19, 21-25 and 28-36 remain pending in the present application, including independent claims 12 and 25. All of the claims are directed to a smoking article having a low carbon monoxide delivery. The smoking article includes a wrapping paper surrounding a column of a smokable filler. The wrapping paper has a fiber basis weight of less than about 18 gsm. As now amended, all of the claims require the smoking article to have a carbon monoxide delivery of less than about 12 mg per smoking article and a carbon monoxide to tar ratio of about 1 or less. Support for the above amendments can be found particularly in Examples 3 and 4 of the present application.

In the Office Action, page 17 of the application was objected to for an informality. In response, the language objected to has been deleted. Further, Applicant has amended page 1 of the application to include an updated and complete listing of related applications.

In the Office Action, the claims were rejected under 35 U.S.C. § 102 or, in the alternative, under 25 U.S.C. § 103 in view of U.S. Patent No. 6,138,684 to Yamazaki, U.S. Patent No. 5,730,840 to Hampl, and U.S. Patent No. 5,893,372 to Hampl. The '840 Patent and the '372 Patent are both owned by the assignee of record and both list the present inventor as an applicant. Further, the present application is a continuation-in-part of the '372 Patent.

In the Office Action, it was stated that even though all of the above three cited references fail to disclose a carbon monoxide delivery for a smoking article made from a paper disclosed therein, it would have been inherent for the smoking articles disclosed in the above three references to have the same carbon monoxide properties. In response, Applicant has amended his claims to now require that the carbon monoxide delivery be below about 12 mg per smoking article and that the smoking articles have a carbon monoxide to tar ratio of less than or equal to about 1. Applicant submits that the smoking articles as now defined in the claims are not inherent in the prior art.

For example, none of the above three-cited references disclose the discovery made by the present inventor that a paper wrapper having a relatively low fiber basis weight can be used to form a smoking article that delivers relatively low amounts of carbon monoxide and a desired carbon monoxide to tar ratio. Further, it is well settled that one of the criteria for determining whether a claimed element is inherently disclosed in a prior art reference is certainty. Inherency may not be established by probabilities or possibilities. The mere fact that a thing may result from a given set of circumstances is not sufficient.

In the present case, Applicant submits that a low fiber basis weight paper will not always necessarily result in a smoking article having the carbon monoxide deliveries as now claimed. For this reason, Applicant submits that the claims as now amended patentably define over the prior art of record.

In the Office Action, claims 1-7, 9-14, and 18-24 were also rejected under the ~~Judicially created Doctrine of Obviousness Type Double Patenting~~ as being unpatentable over claims 4, 5, 8, 15, and 18 of U.S. Patent No. 6,305,382. The claims as now amended, however, include limitations directed to carbon monoxide delivery. Since original claim 27 which defined a carbon monoxide delivery for a smoking article was not rejected under obviousness-type double patenting over the '382 Patent, it is respectfully submitted that this rejection is now moot.

In summary, Applicant submits that the claims as now amended patentably define over the prior art of record and are in complete condition for allowance. Should any issues remain after consideration of this Amendment, however, then Examiner Lopez is invited and encouraged to telephone the undersigned at his convenience.

Please charge any additional fees required by this Amendment to Deposit Account No. 04-1403.

5/2/03

Date

Respectfully submitted,



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